

REMARKS

I. Introduction

Claims 10-15 and 17-19 are pending in the present application after cancellation of claim 16 and addition of claim 19. Claims 11-13 and 17 have been withdrawn from further consideration. Claims 10, 13, 15 and 18 have been amended. Applicants note that claim 13 has been amended to respond to the Examiner's 35 U.S.C. § 112, second paragraph, rejection.

Applicants respectfully request that the Examiner acknowledge the claim for foreign priority and provide an indication that all of the certified copies of the priority documents have been received.

II. Rejection of Claims 10, 14-16 and 18 Under 35 U.S.C. § 112, second paragraph

Claims 10, 14-16 and 18 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.¹

Regarding claim 10, the Examiner asks "what is the structure contacting ("contact" on line 3)?" Applicants note that the meaning of the claimed feature is quite clear, particularly when viewed in light of the Specification. For example, the Substitute Specification clearly indicates on page 3, l. 17-20, that "the seals in areas 20 and 40 create a closed volume between sensor means 10 and glass pane 50 which is indicated in Figure 1 by reference number 32," which closed volume 32 is "referred to below as **contact space 32** between sensor means 10 and glass pane 50." Accordingly, the claimed "structure" contacts the sensor device and the glass pane, and the "contact space" is the space within the structure that is located between the sensor device and the glass pane.

Regarding claim 13, which has been withdrawn from further consideration, the Examiner asks "what do the 'medium' (line 2) and 'the medium' (line 3) correspond to in the drawings/written-specification?" In addition, the Examiner states that "there is a single material that defines the 'medium' (p. 1, line 7), yet claim 13 refers to two (different) mediums ('medium' of line 2, 'medium' of line 3)." Furthermore, the Examiner asks "what does 'optically' and

¹ Although the Examiner states that claims "10, 14-16 and 18 are rejected," the Examiner actually discusses claims 10, 13, 15 and 18 in the detailed discussion of the rejection.

‘condensed’ mean?” In response to the Examiner’s questions, Applicants have amended claim 13 to recite “at least one of an **optically-transparent liquid medium** and an **NIR-transparent liquid medium**.” As clearly indicated on p. 7, l. 12-13 of the Substitute Specification, “contact space 32 may also be filled bubble-free with an optically and, depending on the application, also NIR-transparent, inert, liquid medium.” Accordingly, the Substitute Specification clearly indicates that the “medium” is the material that fills the contact space 32, and the “medium” may be “optically-transparent liquid” and/or “NIR-transparent liquid.” Applicants note that the amendments to claim 13 obviate the Examiner’s question regarding the meaning of “optically” and “condensed.”

Regarding claim 15, the Examiner asks “what does the adjective ‘contact’ (line 4) structurally add to the phrase ‘contact space’?” As explained above in connection with claim 10, the claimed “structure” contacts the sensor device and the glass pane, and the “contact space” is the space within the structure that is located between the sensor device and the glass pane.

Regarding claim 18, the Examiner raised substantially similar questions as those raised in connection with claim 13. In addition, the Examiner noted that claim 18 is a method claim that depends upon an apparatus claim 10. In response to the Examiner’s questions, Applicants have amended claim 18 to depend on method claim 15, as well as recite “providing at least one of an **optically-transparent liquid medium** and an **NIR-transparent liquid medium**.” As noted in connection with claim 13, the Substitute Specification clearly indicates that the “medium” is the material that fills the contact space 32, and the “medium” may be “optically-transparent liquid” and/or “NIR-transparent liquid.”

For the foregoing reasons, claims 10, 13, 15 and 18 are in compliance with 35 U.S.C. § 112, second paragraph.

III. Rejection of Claim 18 Under 35 U.S.C. § 112, first paragraph

Claim 18 is rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In particular, the Examiner asks “what particular materials provide for the two mediums (one ‘optically, condensed’ and the other ‘NIR-transparent, condensed’) alternatives here?” Applicants note that 35 U.S.C. § 112,

first paragraph, enablement requirement is fully met, since the claimed features of amended claim 18, i.e., “providing at least one of an **optically-transparent liquid medium** and an **NIR-transparent liquid medium**,” are fully supported by the specification. As clearly indicated on p. 7, l. 12-13 of the Substitute Specification (which section was unchanged from the corresponding section of the original Specification), “contact space 32 may also be filled bubble-free with an optically and, depending on the application, also NIR-transparent, inert, liquid medium.” Accordingly, the Substitute Specification clearly indicates that the “medium” is the material that fills the contact space 32, and the “medium” may be “optically-transparent liquid” and/or “NIR-transparent liquid.”

IV. Rejection of Claims 10 and 14 Under 35 U.S.C. §102(b)

Claims 10 and 14 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,437,560 ("Kalb"). Applicants respectfully submit that the rejection should be withdrawn for at least the following reasons.

To anticipate a claim under § 102(b), a single prior art reference must identically disclose each and every claim element. See Lindeman Machinenfabrik v. American Hoist and Derrick, 730 F.2d 1452, 1458 (Fed. Cir. 1984). If any claimed element is absent from a prior art reference, it cannot anticipate the claim. See Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997). Additionally, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected claims, as discussed above. See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). To the extent that the Examiner may be relying on the doctrine of inherent disclosure for the anticipation rejection, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Applicants note that claim 10 has been amended to incorporate the features substantially corresponding to the features contained in claim 16, which claim 16 was not rejected in view of any prior art. Amended claim 10 recites “an arrangement for performing: a) heating an inside of the contact space; b) following the heating, sealing the contact space; and c) subsequent to the sealing, cooling the inside of the contact space.” Applicants respectfully

submit that Kalb clearly does not teach or suggest this claimed feature. In particular, Kalb does not disclose a contact space located between the sensor device and the glass pane; instead, the sensor is isolated from the vacuum chamber which is a contact space with a vacuum and a seal. Further, Kalb does not disclose attachment nubs, because the stops 46 of Kalb are not usable for attachment.

For at least the foregoing reasons, claim 10 and its dependent claim 14 are not anticipated by Kalb.

With respect to newly introduced claim 19, Applicants note that Kalb clearly fails to anticipate this claim. Kalb discloses a suction cup combined with an isolated sensor, but Kalb does not disclose a glass pane; instead, Kalb discloses a sheet. Furthermore, Kalb does not disclose a contact space located between the sensor device and the glass pane; instead, the sensor is isolated from the vacuum chamber which is a contact space with a vacuum and a seal. In addition, Kalb does not disclose attachment nubs, because the stops 46 of Kalb are not usable for attachment.

V. Rejection of Claims 10, 15 and 18 Under 35 U.S.C. § 102(b)

Claims 10, 15 and 18 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,556,493 (“Teder '493”). Applicants respectfully submit that the rejection should be withdrawn for at least the following reasons.

To anticipate a claim under § 102(b), a single prior art reference must identically disclose each and every claim element. See Lindeman Maschinenfabrik v. American Hoist and Derrick, 730 F.2d 1452, 1458 (Fed. Cir. 1984). If any claimed element is absent from a prior art reference, it cannot anticipate the claim. See Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997). Additionally, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected claims, as discussed above. See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). To the extent that the Examiner may be relying on the doctrine of inherent disclosure for the anticipation rejection, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.”

(See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Claims 10 and 15 have been amended to incorporate the features substantially corresponding to the features contained in claim 16, which claim 16 was not rejected in view of any prior art. Amended claim 10 recites “an arrangement for performing: a) heating an inside of the contact space; b) following the heating, sealing the contact space; and c) subsequent to the sealing, cooling the inside of the contact space.” Amended claim 15 recites “generating a partial vacuum in the contact space, wherein the generating the partial vacuum includes: heating an inside of the contact space, following the heating, sealing the contact space, and subsequent to the sealing, cooling the inside of the contact space.” Applicants respectfully submit that Teder ‘493 clearly does not teach or suggest these claimed features.

For at least the foregoing reasons, Applicants submit that claims 10 and 15, as well as dependent claim 18, are not anticipated by Teder ‘493.

With respect to newly introduced claim 19, Applicants respectfully submit that Teder ‘493 clearly fails to anticipate this claim. In particular, Teder ‘493 clearly does not teach or suggest any attachment nubs.

Applicant further submit that even if one of ordinary skill in the art were somehow motivated to combine the teachings of Kalb and Teder ‘493, with which assumption Applicants do not agree, the hypothetical combination would fail to result in the claimed invention of claim 19, since both Kalb and Teder ‘493 fail to teach or suggest attachment nubs. In particular, Kalb only discloses “stops 46,” which are not usable for attachment, and Teder ‘493 merely discloses an adhesive interlayer. In any case, there wouldn’t be any motivation to combine the teachings of Kalb and Teder ‘493, since Kalb and Teder ‘493 are in completely unrelated fields of endeavor.

Conclusion

In light of the foregoing, Applicants respectfully submit that all of the pending claims 10, 14, 15 and 18-19 are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

Respectfully submitted,

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